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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,403	01/22/2001	Veronique Douin	05725.0833-00	7304

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EXAMINER

BERMAN, ALYSIA

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 04/10/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,403

Applicant(s)

AUBRUN ET AL.

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-85 is/are pending in the application.
- 4a) Of the above claim(s) 10,22,26-29,31,32,34-49,52-54 and 85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9,11-21,23-25,30,33,50,51 and 55-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of (a) a polycondensate of polyethylene glycol comprising 150 or 180 mol of ethylene oxide, stearyl alcohol and methylenebis(4-cyclohexylisocyanate) (SMDI), (b) polyethylene glycol isostearate and (c) behenyltrimethylammonium chloride in Paper No. 6 is acknowledged. The traversal is on the ground(s) that a search and examination of all of the species would not be unduly burden because it is likely that art encompassing each of the elected species would also encompass the other claimed species. This is not found persuasive because a reference anticipating or rendering obvious one species would not necessarily anticipate or render obvious the other species. Therefore, a separate search and examination of each and every possible combination of components (a)-(c) would have to be conducted.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 10, 22, 26-29, 31, 32, 34-49, 52-54 and 85 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species of the invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

Specification

3. The attempt to incorporate subject matter into this application by reference to G. Fonnum, J. Bakke and Fk. Hansen – Colloid Polym. Sci 271, 380-389 (1993) is

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improper because it attempts to incorporate essential material by reference to non-patent publication. See MPEP§ 608.01(p).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

5. Claims 1, 21, 55, 56 and 70-80 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 1 and 70-80 are indefinite because they contain the misspelled word, "amphiphilc".

7. Claim 21 is indefinite because it is unclear if the information in parentheses is a required limitation of the claims.

8. Claims 55 and 56 are indefinite because they contain the misspelled word, "tetraalkyammonium".

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-9, 11-21, 23-25, 30, 33, 50, 51 and 55-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,925,341 (341) in combination with WO 99/36047 (047).

US '341 is directed to oil-in-water nanoemulsions that contain nonionic amphiphilic lipids and aminated silicones wherein the oily globules have an average size of less than or equal to 150 nm (title and abstract). For polyethylene glycol isostearate as the nonionic amphiphilic lipid, see column 3, lines 20-24. For 0.3 to 3 wt.% of aminated silicone, see column 7, lines 1-5. For ionic amphiphilic lipids such as behenyltrimethylammonium chloride, see column 11, lines 16-18. The amount of ionic amphiphilic lipid is from 0-10 wt.% of the emulsion (col. 11, lines 24-29). For 5-40 wt.% oil, see column 11, lines 30-64. For water-soluble, water-dispersible and liposoluble cosmetic and dermatopharmaceutical active agents, see column 12, lines 15-33. For oil globules sizes in the range of 30 to 150 nm and 40 to 100 nm, see column 12, lines 45-49.

Example 1 at column 13, line 64 to column 14, line 17 contains 4.5 wt.% polyethylene glycol isostearate, 1.6 wt.% behenyltrimethylammonium chloride, 15 wt.% avocado oil and 1.75 wt.% amodimethicone with an oil globule size of about 95 nm. See

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claims 1, 2 and 3 for the weight ratio of oil or oily phase to amphiphilic lipid. See claim 8 for an aminated silicone. Sees 14-16 for the amount of aminated silicone in the emulsions. See claims 17-20 for an ionic amphiphilic lipid. See claims 21-25 for the amount of ionic amphiphilic lipid. See claims 26 and 27 for the amount of oil. See claim 28 for cosmetic and dermatopharmaceutical active agents. See claim 29 for a composition containing the nanoemulsion of the reference. See claims 30-32 for the average size of the oil globules. See claims 38 and 39 for application of the nanoemulsion and a composition comprising the nanoemulsion to keratin material.

US '341 does not teach a nonionic block polymer as instantly claimed. US '341 does teach at column 12, lines 15-34 that actives such as thickeners may be added to the nanoemulsion. WO '047 teaches the use of polyether-polyurethane block copolymers in hair care compositions for the enhanced rheological and conditioning benefits (abstract). For Applicant's elected species of nonionic polymer, see Aculyn 46 at page 5, lines 5-12. For an amount of nonionic polymer that falls within the instantly claimed weight percent range, see page 5, lines 19-21. The nanoemulsion obtained by the combination of cited prior art containing the same components as instantly claimed in the same amounts would be expected to exhibit the same properties. Therefore, absent evidence to the contrary, the turbidity of the nanoemulsion is not considered critical to the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add a nonionic block polymer as taught by WO '047 to the nanoemulsion of

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US '341 with the reasonable expectation of obtaining enhanced rheological and hair conditioning benefits.

Unexpected Results

12. It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

In the instant case, no data was seen in the specification.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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14. Claims 1-9, 11-13, 17-21, 23-25, 30, 33, 50, 51, 55-65 and 70-84 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 14-25, 29-31 and 33 of copending Application No. 09/903,768. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both directed to oil-in-water nanoemulsions comprising at least one amphiphilic lipid and at least one nonionic polymer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

15. Applicant is advised that should claims 1, 2, 75 and 76 be found allowable, claims 70-74, 77, 78, 80 and 81 will be objected to under 37 CFR 1.75 as being substantial duplicates thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Correspondence

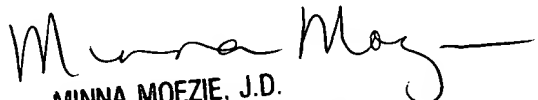
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
April 4, 2002


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SUPERVISORY PATENT EXAMINER
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